# UNITED STATES PATENT AND TRADEMARK OFFICE

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/691,792 | 10/18/2000 | Yakov Kamen | 007287.00020 | 5769 |

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| EXAMINER |
|---|
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

| | | Application No. | Applicant(s) |
| | | 09/691,792 | KAMEN ET AL. |
| **Office Action Summary** | | Examiner | Art Unit | |
| | | Dominic D. Saltarelli | 2623 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) ☒ Responsive to communication(s) filed on <u>08 February 2008</u>.

2a) ☐ This action is **FINAL**.     2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) ☒ Claim(s) *1,4-6,8 and 10-15* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1,4-6,8 and 10-15* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All   b) ☐ Some * c) ☐ None of:

    1. ☐ Certified copies of the priority documents have been received.

    2. ☐ Certified copies of the priority documents have been received in Application No. _____.

    3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

## DETAILED ACTION

### *Response to Arguments*

1.     The rejection of claims 1, 10, and 14 under 35 U.S.C. 112 first paragraph is withdrawn.

2.     Applicant's arguments with respect to claims 1, 10, and 14 have been considered and are not persuasive.

Regarding claim 1, applicant argues that the examiner has not presented sufficient motivation to combine the Watanabe reference with the combination of Nikolovska, Handelman, and Beer (applicant's remarks, page 6).

In response, the examiner has further elaborated upon the reasons one of ordinary skill in the art would modify the combination of Nikolovska, Handelman, and Beer in view of Watanabe.

Also regarding claim 1, applicant argues that the time triggers disclosed by Watanabe relate only to a change of a broadcast program status (applicant's remarks, page 6).

In response, the cited portions of Watanabe refer to a user manually inputting time information to trigger a specific event at that time for controlling the display of particular information in an editing environment (a user interface implemented on a data display control information editing apparatus, col. 45, lines 6-23 and col. 46, lines 3-34).

Similarly, regarding claims 10 and 14, applicant argues that the combination of

Nikolovska, Handelman, Beer, and Watanabe fails to disclose "in response to

determining that the predefined time ahs been reaches, modifying the electronic

programming guide in accordance with the user requested change to at least one

portion of the electronic program guide." Citing that Beer does not disclose making the

user requested change in response to a predetermined time, and that Watanabe does

not disclose making a user requested change (applicant's remarks, page 7).

In response to applicant's arguments against the references individually, one

cannot show nonobviousness by attacking references individually where the rejections

are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208

USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir.

1986). In this instance, the only missing element once Nikolovska, Handelman, and

Beer have been combined is for the change to take place at a predetermined time.

Therefore, the teaching of Watanabe of allowing a user to input a predetermined time

for a change to occur is sufficient to establish a *prima facie* case of obviousness.

3.      Applicant's arguments with respect to claim 8 have been considered and is moot

in view of the new grounds of rejection.

## Claim Rejections - 35 USC § 103

4.      The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set
forth in section 102 of this title, if the differences between the subject matter sought to be patented and
the prior art are such that the subject matter as a whole would have been obvious at the time the
invention was made to a person having ordinary skill in the art to which said subject matter pertains.
Patentability shall not be negatived by the manner in which the invention was made.

5.      Claims 1, 4-6, and 10-15 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Nikolovska et al. (6,281,898, of record) [Nikolovska] in view of

Handelman et al. (6,312,336, of record), Beer (5,793,368, of record), and Watanabe et

al. (6,223,347, of record) [Watanabe].

         Regarding claims 1, 10, 13, and 14, Nikolovska discloses a system for

providing an electronic program guide (EPG) (figs. 1-6) configured to display

programs from a plurality of program sources on a plurality of user-selectable

channels (the third axis 104 lists the available channels, col. 2, lines 55-65)

comprising an EPG presentation generator (fig. 7, processor 2) for generating a

displayable EPG presentation (as shown in figs. 1-6), wherein the EPG

presentation is configured to be displayed as a three-dimensionally set of three-

dimensional surfaces textured by pre-processed scheduling data (as shown in

figs. 1-6, col. 2, lines 41-65) and a signal filter (col. 3, lines 7-12) that is based on

user input (such as highlighting and selection of items, col. 3, lines 52-67).

         Nikolovska fails to disclose the user input is a request for the use of a

background and a morphing engine including a database of different EPG

presentation solutions, the morphing engine configured to select one of said EPG

presentation solution from the database based on a control command generated

by a signal filter, wherein the control command is generated by the signal filter based on a time trigger.

In an analogous art, Beer discloses a user interface system including a morphing engine (resident PGUI which controls the display, col. 3, lines 50-67) including a database of different presentation solutions (UIL user interface descriptions saved in the local storage unit for later retrieval, col. 3, lines 50-67), and based on a control command (user input) generated by a signal filter (input from the user input devices, such as pointing device or keyboard, col. 3, lines 16-25), one of said solutions is selected from said database for display (col. 3, lines 23-25), which includes the request for a different background (users set 'widget attributes', col. 3, lines 57-59, which includes backgrounds, col. 10, lines 57-66), providing the benefit of allowing a user to select from a variety of different styles for a user interface (col. 3, lines 23-25).

It would have been obvious at the time to a person of ordinary skill in the art to modify the system of Nikolovska to include a morphing engine including a database of different presentation solutions, the morphing engine configured to select one of said EPG presentation solution from the database based on a control command generated by a signal filter, wherein the user input is a request for a different background, as taught by Beer, for the benefit of allowing a user to select from a variety of different styles for the EPG interface.

Nikolovska and Beer fail to disclose the control command is generated by the signal filter based on a time trigger.

In an analogous art, Watanabe discloses a display system wherein user input display operations include predefined time triggers which are generated at a predefined time to initiate control of a display (col. 45, lines 20-23 and col. 46, lines 3-34), granting a user enhanced control over control of the output of the display.

It would have been obvious at the time to a person of ordinary skill in the art to modify the system of Nikolovska and Beer to include the control command is generated by the signal filter based on a time trigger, as taught by Watanabe, for the benefit of granting a user enhanced control over control of the manner of output of the EPG. One example would be alterable backgrounds based on time of day or seasonal changes (e.g. a sunrise during morning hours, and a starry sky during nighttime hours).

Regarding claim 4, Nikolovska, Beer, and Watanabe disclose the system of claim 1, wherein the morphing engine further includes a set of parametrical functions (Beer's 'widgets', col. 3, lines 50-67) and wherein the control command generated by the signal filter creates a request for a function of the set of parametrical functions and parameters associated with the requested function (Beer teaches users can selectively add, delete, select, and modify said widgets, col. 3, lines 50-67).

· Regarding claims 5, 11, and 15, Nikolovska, Beer, and Watanabe disclose the system, method, and computer readable medium of claims 1, 10, and 14, wherein the morphing engine further includes a mix of presentation solutions and functions, and wherein the control command generated by the signal filter creates a request for one of said presentation solutions (Beer teaches users may select a visual style, col. 3, lines 23-25, in addition to selecting individual 'widgets', col. 4, lines 50-67).

Regarding claim 6, Nikolovska, Beer, and Watanabe disclose the system of claim 1, wherein the morphing engine further includes a mix of presentation solutions and functions, and wherein the control command generated by the signal filter creates a request for a function and parameters associated with the requested function (Beer teaches users may select individual 'widgets', col. 4, lines 50-67, in addition to selecting a visual style, col. 3, lines 23-25).

Regarding claim 12, Nikolovska, Beer, and Watanabe disclose the method of claim 10, wherein the broadcast receiving device comprises a set top box (Nikolovska, col. 2, lines 9-23).

6.    Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nikolovska, Beer, and Watanabe as applied to claim 1 above, and further in view of Hendricks et al. (5,682,195) [Hendricks].

Regarding claim 8, Nikolovska, Beer, and Watanabe disclose the system of claim 1, but fail to disclose a second signal filter based on input from a broadcaster.

In an analogous art, Hendricks teaches receiving commands from a broadcaster which control the display of a user interface presented to a user (network control 304 which sends information signals to a set top terminal to control the display of menus and interactive features to a user, col. 21 line 65 - col. 22 line 63), providing the benefit of making "on the fly" changes to displays presented to a user (col. 22, lines 39-49).

It would have been obvious at the time to a person of ordinary skill in the art to modify the system disclosed by Nikolovska, Beer, and Watanabe to base a signal filter on input from a broadcaster, as taught by Hendricks, for the benefit of enabling the broadcaster to control the display presented to the user in the event that immediate changes need to be made, such as for a local emergency or for important regional events.

### Conclusion

7.     The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patent No. 5,559,548 to Davis et al., which discloses changing the backgrounds of electronic program guides in response to predetermined time triggers was known in the art (see col. 17, lines 16-40), a feature relied upon by the examiner regarding claims 1, 10, and 14 above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dominic D. Saltarelli whose telephone number is (571) 272-7302. The examiner can normally be reached on Monday - Friday 9:00am - 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DS

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